

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application, and for allowing claim 14 and indicating that claims 9-12 contain allowable subject matter.

Information Disclosure Statements (IDS)

As an initial matter, Applicant respectfully notes that in response to Applicant's IDS filed May 18, 2008, the Examiner has returned the SB-08 form. However, the Examiner has crossed out the foreign patent documents JP-10-142298 and JP-10-22521, indicating that they are not considered. Similarly, for the IDS filed August 19, 2004, a number of foreign patent documents were also indicated in an Office Action dated January 18, 2006 as not considered.

Applicant respectfully notes that, according to 37 CFR 1.98, when a reference is filed in a foreign language, a concise explanation of the relevance of a foreign document is required for the foreign document. The English translation of the foreign office action or the International Search Report suffices for the requirement for a concise explanation of the relevance. Applicant supplied such a search report, which was initialed as considered. Furthermore, Applicant had additionally submitted the English abstracts of the foreign documents. Accordingly, Applicant respectfully requests appropriate consideration of all the submitted foreign documents and return of appropriately initialed SB-08 forms.

Disposition of Claims

Claims 1-2 and 4-15 were pending in this application. By way of this reply, claims 1-2, 9-12, and 15 have been amended, and new claims 16-30 have been added. Thus, claims 1-2 and 4-30 are currently pending. Claims 1, 9-12, 14-15, and 18 are independent. The remaining claims depend, directly or indirectly, from claims 1, 9-12, 14-15, and 18. In particular, claim 13 is a multiple-dependent claim that depends from claims 1-2 and 4-10.

Claim Amendments

Claim 1 has been amended to clarify that the reference current is generated by a current supply. No new matter has been added by way of this amendment, as support for this amendment may be found, for example, in Figs. 4B and 4C and the associated text of the present application.

Claim 2 has been amended to remove a redundant feature and to correct antecedent basis. No new matter has been added by way of these amendments.

Claims 9-12 have been rewritten in independent form including all limitations of un-amended claim 1 and intervening claims. No new matter has been added by way of these amendments.

New claims 16-30 have been amended to recite features disclosed in the specification and recited by existing claims. No new matter has been added by way of these amendments.

Allowable Subject Matter

Claim 9-12 were objected to as being dependent upon a rejected base claim. By way of this reply, claims 9-12 have been rewritten in independent form including all of the limitations of the base claim and the intervening claims. Thus, claims 9-12 are now in condition of allowance.

Rejection(s) under 35 U.S.C § 102

Claims 1-2, 5 and 15 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,737,111 (“Mori”). Independent claims 1 and 15 have been amended by way of this reply as explained above. To the extent that the rejection may still apply to the amended claims, this rejection is respectfully traversed.

The present invention is directed to a photoelectric conversion circuit and test apparatus. Referring to, e.g., Figs. 4B and 4C and the associated text of the present application, a variable current supply 76 is used for generating an offset current, and a current supply 108 is used to generate a reference current. The reference current and the current generated by the light receiving unit are compared by a comparator 110. Accordingly, the Independent claims 1 and 15 each requires, in part, a variable current supply, a current supply for generating a reference current, and a comparator. Mori, in contrast the claimed invention, fails to show or suggest at least the above-mentioned limitations.

In the instant Office Action (page 3, lines 19—21), the Examiner admits that the purported reference current of Mori is merely a zero current level *detected* by an offset detecting

circuit. Thus, the purported reference current cannot possibly be *generated* by a current supply that is different from the variable current supply.

In addition, the Examiner refers to col. 4, lines 15-18 of Mori and asserts that Mori provides a comparator. This is incorrect. The part of disclosure the Examiner has relied upon merely provides an offset *detecting* circuit for detecting a zero level. As known to a person of ordinary skill in the art, detecting a zero level of a current is achieved using an integrator or a filter, but not a comparator. Mori is, in fact, completely silent with respect to a comparator.

In view of the above, Mori fails to disclose each and every limitation of amended independent claims 1 and 15. Thus, amended independent claims 1 and 15 of the present application are patentable over Mori. Dependent claims 2 and 5 are allowable for at least the same reasons set forth above. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection(s) under 35 U.S.C § 103

Claims 4 and 6-8

Claims 4 and 6-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mori. For the following reasons, this rejection is respectfully traversed.

As discussed above, independent claim 1 is patentable over Mori. Dependent claims 4 and 6-8 are allowable for at least the same reasons set forth above. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 13

Claim 13 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Mori in view of U.S. Patent No. 5,526,164 ("Link"). For the following reasons, this rejection is respectfully traversed.

As discussed above, independent claim 1 is patentable over Mori. Link, like Mori discussed above, also fails to show or suggest the claimed invention as recited independent claim 1, or to supply that which Mori lacks. In particular, Link is silent with respect to at least the current supply for generating a reference current. This is also evidenced by the fact that Link was relied upon by the Examiner merely to supply a bias current supply. Applicant further notes that the purported bias current supply used to activate a laser is distinctly different from the current supply for generating a reference current.

In view of the above, Mori and Link, whether considered separately or in combination, fail to show or suggest the claimed invention as recited in amended independent claim 1. Thus, amended independent claim 1 of the present application is patentable over Mori and Link. In addition, amended independent claims 9-10 are also allowable. Thus, dependent claim 13, which is a multiple-dependent claim depending from claims 1-2 and 4-10, is allowable for at least the same reasons set forth above. Accordingly, withdrawal of this rejection is respectfully requested.

Patentability of New Claims

Among the newly added claims, claims 16 and 17 depend from amended independent claim 15, and are allowable for at least the same reasons discussed above with respect to claim 15.

New claim 18 is an independent claim that requires, in part, a predetermined current value that is calibrated in advance being subtracted from the current value of the current generated by the light receiving unit. Mori and Link fail to show or suggest at least these limitations. For example, referring to col. 4, lines 15-24 and lines 42-54, and Fig. 3 of Mori, the “subtractive” current I_1 varies with time and changes with the signal pattern. Thus, the current to be subtracted cannot possibly be *predetermined* that is calibrated in advance. Link is similarly silent with respect to the above-mentioned limitations. Thus, independent claim 18 and dependent claims 19-30 are patentable over Mori and Link for at least the reasons set forth above.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591, Reference No. 02008.156001.

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Respectfully submitted,

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